

REMARKS

Claims 1-9 are pending in this application. Claim 1 is independent. In light of the remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1-3 and 6 under 35 U.S.C. § 103(a) as being unpatentable over *Furuhashi et al.* (USP 5,909,205); rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over *Furuhashi et al.* in view of *Nally et al.* (USP 5,808,629); rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Furuhashi et al.* in view of *Tada et al.* (USP 6,252,563); and rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Furuhashi et al.* and further in view of *Selwan et al.* (USP 5,526,025). Applicants respectfully traverse these rejections.

Objection to the Drawings

In the Office Action Summary, the drawings filed on July 15, 1999 are objected to by the Examiner; however, Applicants note that no further information regarding the drawing objection is contained in the Detailed Action. In response to the drawing objection, Applicants are filing herewith a replacement sheet for Fig. 13 correcting the margins as required by the Form PTO 948 "Notice of Draftspersons' Patent Drawing Review" dated September 18, 1999. In light of this filing, Applicants respectfully request that the

Examiner withdraw the objection to the drawings. If the Examiner continues to object to the drawings, Applicants respectfully request that the Examiner provide a detailed explanation of the changes deemed necessary.

Claim Rejections - 35 U.S.C. § 103 - *Furuhashi et al.*

In support of the Examiner's rejection of claim 1, the Examiner admits that *Furuhashi et al.* does not teach a display control and a main control section. However, the Examiner asserts it would have been obvious to one of ordinary skill in the art at the time of the invention to split the frame/line memory control circuit into separate sections, i.e., a display control section and a main control section as per the instant claim because this would reduce the processing burden on the main CPU.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation ... to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

First, as the Examiner has failed to provide references that teach or suggest all of the claimed elements, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

In addition to the above, it is respectfully submitted that the Examiner has failed to provide proper motivation in support of his rejection of the claims under 35 U.S.C. § 103(a).

In order for a *prima facie* case to exist, the prior art must suggest the desirability of the claimed invention, providing motivation to make the combination proposed by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d1453, 1457-58 (Fed.Cir. 1998). The level of skill in the art cannot be relied upon to provide this suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In support of the Examiner's rejection of claim 1, the Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to split the frame/line memory control circuit into separate sections, i.e., a display control section and a main control section as per the instant claim because this would reduce the processing burden of the main CPU. It is respectfully submitted that there is no teaching or suggestion in *Furuhashi et al.* to split the frame/line memory control circuit into separate sections as asserted by the

Examiner. As such, the only source for the Examiner's motivation comes from Applicants' disclosure, which amounts to impermissible hindsight. It is respectfully submitted that as the Examiner has failed to provide proper motivation in support of his rejection of claim 1 under 35 U.S.C. § 103, the Examiner has failed to establish a *prima facie* case of obviousness. As such, it is respectfully requested that the outstanding rejection be withdrawn.

In addition to the above arguments, it is respectfully submitted that the Examiner's assertion that the frame/line memory control circuit is considered functionally equivalent in performing the same task is insufficient in establishing a *prima facie* case of obviousness.

It is respectfully submitted that in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

While the Examiner asserts that the frame/line memory control circuit is considered functionally equivalent in performing the same task, it is respectfully submitted that the equivalency is not recognized in the prior art as cited by the Examiner. As the equivalency is not recognized in the prior art, it is inappropriate for the Examiner to rely on equivalence as a rationale for

supporting an obviousness rejection. Thus, as the Examiner's argument that the frame/line memory control circuit is considered functionally equivalent to the display control section and the main control section as set forth in claim 1 is inappropriate, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

Finally, in addition to the above, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness by failing to provide references that teach or suggest all of the claimed elements.

It is respectfully submitted that the present invention as set forth in claim 1 recites, *inter alia*, a programmable display device comprising a display control section reading out the display data by specifying the address of the display data for one line which has a possibility to be displayed on the screen to the main memory from which the display data is transferred, based on the stored information, causing the data processing circuit to perform the data transfer and select the line memory to store the display data. While *Furuhashi et al.* discloses a liquid crystal display control device which can display pictures in a magnification mode by using only a memory having low speed access and low storage capacity, it is respectfully submitted that *Furuhashi et al.* fails to teach or

suggest this element as set forth in claim 1. Further, the Examiner fails to provide any support in his rejection of claim 1 that *Furuhashi et al.* teaches or suggests this claim element. As the Examiner has failed to provide a reference that teaches or suggests all of the claimed elements, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-9 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$110.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Charles Gorenstein
Charles Gorenstein, #29,271

CG
CG/CMV/jdm
1152-0237P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Replacement sheet for Fig. 13